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In re Application of : **OFFICE OF PETITIONS**
Logan, Burd, Durgin, Read, Doe, :
Colella, Hale, Mansfield, :
Palone, Boone, and Santos : **DECISION REFUSING STATUS**
Application No. 10/769,383 : **UNDER 37 CFR 1.47(a)**
Filed: 31 January, 2004 :
Atty Docket No. E-05 :

This is in response to the request for reconsideration which is treated as a renewed petition filed under 37 CFR 1.47(a)¹ on 25 April, 2005.

The petition is again **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 31 January, 2004, without an executed oath or declaration. Accordingly, on 15 June, 2004, Initial Patent Examination Division mailed a Notice

¹ A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

to File Missing Parts of Nonprovisional Application, requiring, *inter alia*, an executed oath or declaration and a surcharge for its late filing.

In response, on 15 December, 2004, petitioners filed a four (4) month extension of time accompanied by a declaration naming James D. Logan, Dana Burd, Scott A. Durgin, Gregory J. Read, Brian D. Doe, Vincent E. Colella, MacFarland Hale, Paul M. Mansfield, Michael G. Palone, Stephen Boone, and Jeffrey M. Santos as joint inventors, signed by all joint inventors except Doe on behalf of themselves and joint inventor Doe. The petition filed on 15 December, 2004, was dismissed on 24 January, 2005.

On 25 April, 2005, the present renewed petition was filed. Petitioners request reconsideration, stating that (1) non-signing inventor Doe was presented with a copy of the declaration listing all of the inventors and (2) that "[t]here is no requirement that a single declaration form must name all of the inventors."

Petitioners' arguments have been considered, but are not persuasive.

37 CFR 1.63 states, in pertinent part:

(a) An oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must:

...

(2) Identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;

...

A review of the record reveals that petitioners submitted a first page of the declaration listing Logan and Burd as joint inventors, a supplemental sheet numbered 1 of 3 listing Durgin, Read, and Doe as joint inventors, a supplemental sheet numbered 2 of 3 listing Colella, Hale, and Mansfield as joint inventors, a supplemental sheet numbered 1 of 3 listing Palone, Boone, and Santos as joint inventors, and a supplemental sheet numbered 1 of 3 listing Palone and Boone as joint inventors.

At the outset, although petitioners' counsel states that all of the listed applicants are inventors, the inventorship does not appear to be clear to the inventors themselves. While counsel

may intend that all of the inventors be listed as joint inventors, the duplicate page numbers leave ambiguity as to who the actual inventors are. While it is not required that all of the inventors sign on the same copy of the declaration, the declaration signed by all of the inventors must list all of the inventors. The declaration submitted to date, however, does not list all of the inventors.

Based on the numbering of the sheets, the inventorship of this application could be construed as (a) Logan, Burd, Durgin, Read, Doe, Colella, Hale, and Mansfield; (b) Logan, Burd, Palone, Boone, Santos, Colella, Hale, and Mansfield, or (c) Logan, Burd, Palone, Boone, Collella, Hale, and Mansfield. As such, the declaration clearly does not meet the requirements of 37 CFR 1.63(a)(2).

Additionally, with regard to joint inventor Boone's signature on the page that does not list joint inventor Santos, joint inventor Boone clearly did not sign a declaration listing Santos as a joint inventor, as Santos was not listed on the first page, supplemental page 1, or supplemental page 2 of the declaration signed by Boone.

The petition does not comply 37 CFR 1.47(a)(2).

At the outset, assuming, *arguendo*, Doe was presented with a declaration listing Santos as a joint inventor, as stated above, the declaration is ambiguous with regard to inventorship. As such, it cannot be ruled out that Doe refused to sign the declaration due to inventorship *per se*.

Petitioners must therefore show that an application properly naming the inventive entity (specification, including claims, drawings if any, and a declaration correctly stating the inventorship) was sent to inventor Doe along with a request that he sign and return the declaration.

Additionally, as the page numbering and listing of inventor's names is inconsistent across the pages of the declaration, petitioners **must** provide a new oath or declaration in compliance with 37 CFR 1.63 and 1.67, naming the proper inventive entity, signed by all of the signing inventors on behalf of themselves and the non-signing inventor.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



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